REMARKS

As a preliminary matter, claims 1, 2 and 4-9 are objected to based on the reasons set forth on pages 2-3 of the present Office Action. Applicant amends these claims, as indicated herein, and believes that these amendments obviate the Examiner's objections to claims 1, 2 and 4-9.

Claims 1-9 are all the claims pending in the present application. Claims 7 and 8 are allowed. In the present Office Action, the Examiner applies new references to support the rejections of claims 1-6 and 9. Specifically, claims 1-4, 6 and 9 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description required. Claims 1 and 3 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Inoue (U.S. Patent 6,300,882), hereinafter referred to as USP '882. Claims 1 and 6 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Inoue (U.S. Patent 6,337,978), hereinafter referred to as USP '978. Finally, claims 1, 2, 4, 5 and 9 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Takikita (U.S. Patent 6,339,381).

§112, first paragraph Rejections - Claims 1-4, 6 and 9

The Examiner rejects claims 1-4, 6 and 9 under 35 U.S.C. § 112, first paragraph, for the reasons set forth on page 4 of the present Office Action. Specifically, the Examiner alleges:

> Consider claim 1, the limitation of "wherein said normal reception sensitivity is not related to a deactivated state" introduces new matter and fails to comply with the written description requirement because the specification of the present application does not specify or disclose, either implicitly or explicitly, that the normal reception sensitivity is not related to a deactivated state. MPEP 2173.05(i) states that any negative limitation or exclusionary provision must have basis in the original disclosure and any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. § 112, first paragraph. Since the written description of the present application

> does not set forth that the normal reception sensitivity is not related to a deactivated state, the new limitation added to claim 1 introduces a new matter. Applicant is welcomed to point out where in the specification the Examiner can find support for this limitation if Applicant believes otherwise. *See page 4 of Office Action.*

In response, Applicant traverses the Examiner's rejections under 35 U.S.C. § 112, first paragraph, and submits that the limitation added in the previous Amendment does NOT introduce new matter, and is supportable in the original specification. The Examiner only quotes from one portion of MPEP §2173.05(i), but does not recite other relevant portions of the above mentioned MPEP section. Applicant believes that MPEP §2173.05(i), as a whole, obviates the Examiner's rejections under 35 U.S.C. § 112, first paragraph. In addition to the Examiner's quote above, MPEP §2173.05(i) also states, in part, "that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support." In the present case, just because the specification does not expressly, or literally, recite the phrase "the normal reception sensitivity is not related to a deactivated state", does not mean that there is no support for the above discussed limitation in the original specification. Furthermore, it has previously been held that a negative limitation IS definite when the boundaries of the patent protection sought are clear. See In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA171), MPEP §2173.05(i). In the present case, the boundaries of patent protection sought are clear because the claimed normal reception sensitivity, as set forth in claim 1 for example, corresponds to a normal judging level which sets a low reception sensitivity, according to an exemplary embodiment of the invention. *See page 17, lines 11-18.* The normal judging level is NOT described as shut-down or shut-off (i.e., deactivated), therefore, at least based on the above-cited portion of the specification, it is clear that, in an

exemplary embodiment of the present invention, a normal reception sensitivity is not related to a deactivated state. Therefore, at least based on the foregoing, Applicant submits that claims 1-4, 6 and 9 do, in fact, comply with the written description requirement under 35 U.S.C. § 112, first paragraph.

§102(e) Rejections (USP '882) - Claims 1 and 3

With respect to USP '882, Applicant elects to perfect priority under 35 U.S.C. § 119, and request removal of USP '882 as a prior art reference. USP '882 was filed in the United States on August 9, 2000, which is after the filing date of JPA 2000-089009 (March 28, 2000), from which the present application claims benefit of priority. To perfect priority, Applicant submits herewith an English language translation of JPA 2000-089009, a copy of which was submitted on August 10, 2000, and a declaration stating that the translation of JPA 2000-089009 is accurate.

§102(e) Rejections (USP '978) - Claims 1 and 6

The Examiner rejects claims 1 and 6 over USP '978 for the reasons set forth on pages 7-9 of the present Office Action.

With respect to independent claim 1, Applicant submits that USP '978 does not teach or suggest at least the following features of claim 1:

> a reception sensitivity-increasing means for increasing the reception sensitivity in a communication area with an on-the-road equipment in response to the entrance into a communication start area with the on-the-road equipment;
>
> wherein the reception sensitivity-increasing means returns the reception sensitivity back to a normal reception sensitivity of before entering into the communication start area in response to the end of communication with the on-the-road

equipment, wherein said normal reception sensitivity is not related to a deactivated state.

See claim 1.

The Examiner alleges that particular components of USP '978 allegedly correspond to the claim elements set forth in claim 1. However, USP '978 is different from the present invention at least based on the following reasons. USP '978 is directed to a dedicated short-range communication (DSRC) device that measures a power level of a radio wave received from a ground device, which allegedly corresponds to the claimed on-the-road equipment. In USP '978, based on the measured power level of the radio wave from the ground device, certain components of the DSRC device provide power to other components of the DSRC device. *See claim 1, col. 1, lines 6-12, and col. 2, lines 37-57.* Different from the present claimed invention, in USP '978, there are no components that 1) increase the reception sensitivity in a communication area with an on-the-road equipment, and 2) return the reception sensitivity back to the normal reception sensitivity, as described, in part, in claim 1. Even if, *arguendo*, USP '978 discloses the increasing of power to certain components of the device of USP '978 when a radio wave from a ground device exceeds a predetermined value, there is no teaching or suggestion in USP '978 that reception sensitivity is increased or that reception sensitivity is returned back to a normal reception sensitivity. The increase in power does not necessarily mean an increase in reception sensitivity. Increasing power could result in simply more heat being generated or the device operating faster, but does not necessarily result in an increase in reception sensitivity. Furthermore, the fact that power is provided to certain components of the DSRC device of USP '978 based on the measured power level of the radio wave from the ground equipment, indicates that the components (that allegedly affect reception sensitivity) to which power is provided, are

likely in a deactivated state. Thus, Applicant submits that USP '978 does not teach or suggest at least, "wherein said normal reception sensitivity is not related to a deactivated state," as recited in claim 1. At least based on the foregoing, Applicant submits that independent claim 1 is patentably distinguishable over USP '978.

Applicant submits that dependent claim 6 is patentable at least by virtue of its dependency from independent claim 1.

§102(e) Rejection (Takikita) - Claims 1, 2, 4, 5 and 9

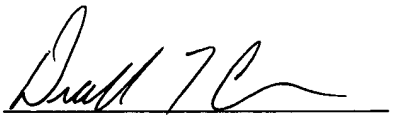
With respect to Takikita, Applicant elects to perfect priority under 35 U.S.C. § 119, and request removal of Takikita as a prior art reference. Takikita was filed in the United States on August 9, 2000, which is after the filing date of JPA 2000-089009 (March 28, 2000), from which the present application claims benefit of priority. To perfect priority, as indicated above, Applicant submits herewith an English language translation of JPA 2000-089009, a copy of which was submitted on August 10, 2000, and a declaration stating that the translation of JPA 2000-089009 is accurate.

Finally, Applicant adds new claim 10 to provide a varying scope of coverage. Applicant submits that this new claim is patentable at least by virtue of its dependency from claim 6.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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